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Shunji Harada

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EXAMINER

CHAI, LONGBIT

ART UNIT

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2131

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,413

Applicant(s)

HARADA ET AL.

Examiner

Longbit Chai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. At present, the pending claims are 1 – 19, 21 and 22.

Response to Arguments

2. Applicant's arguments with respect to the instant claims have been fully considered but are moot in view of the new ground(s) of rejection – see the following Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 – 7, 10 – 13, 15, 18, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. (U.S. Patent 7,096,504), in view of Otsuka et al. (U.S. Patent 6,094,723).

As per claim 1, 5, 15, 18, 19, 21 and 22, Tagawa teaches a **software-management system comprising a portable recording device and an information-processing device** (Tagawa: FIG. 3C & 4D / 4C, Column 2 Line 3 – 7, Column 9 Line 42 – 48 and Column 7 Line 42 – 46: the memory card, including the security processing units, is considered as the portable

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/ removable recording device (e.g., consistent with the disclosure in the instant specification (SPEC: Figure 3 / Element 211 and 213) that can communicate to an receiving unit, where the connected compatible device is qualified as the **information-processing device** (or receiving unit)), the **portable recording device** including:

a normal storage unit having stored therein software that is computer data (Tagawa: Column 2 Line 3 – 7, Column 9 Line 26 – 48 and Column 7 Line 42 – 46: storing usage data) and;

a secure storage unit not directly accessible from outside, and having stored therein license information relating to a usage condition of the software (Tagawa: Column 9 Line 26 – 48, Column 2 Line 3 – 7, and Column 7 Line 42 – 46); and

a tamper-resistant module operable to judge, based on the license information, whether an operation, being one of installing software on the information-processing device and deactivating installed software (Otsuka: see below), is permitted, and when judged in the affirmative, to output to the information-processing device an instruction showing that the operation is permitted (Tagawa: Column 9 Line 26 – 48, Column 2 Line 3 – 7, and Column 7 Line 42 – 46: the memory card, whose protected area stores a Usage Rule and if the Usage Rule indicates that the number of permitted times is "0", the usage rule can not be moved and the connected device (i.e. information processing device) cannot obtain management rights (i.e. usage information / rule) from the memory card (Tagawa: FIG. 3C & 4D / 4C and Column 9 Line 42 – 48) and (b) Examiner notes, in light of that, the information processing device is actually managed by the memory card security module because if the connected device (i.e. the information processing device) cannot obtain usage information / rule from the memory card, then the information processing device has no way to make any determination by itself whether the permission should be granted or not and as such the

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permission instruction is obviously equivalent to be determined solely from the security module (e.g., AKE -- authentication processing unit) on the memory card -- i.e. the permission is granted only when the connected device has successfully performed AKE processing (Column 8 Line 65 -- 67)), and **to rewrite the license information in accordance with the operation** (Tagawa: Column 9 Line 26 -- 48, Column 2 Line 3 -- 7: updating the usage data).

Tagawa only teaches software copy right and usage rule (Tagawa: Column 2 Line 3 -- 7, Column 9 Line 26 -- 48 and Column 7 Line 42 -- 46). However, **Tagawa does not disclose** the software copy right and usage rule being one of installing software on the information-processing device and deactivating installed software.

Otsuka teaches the software copy right and usage rule **being one of installing software on the information-processing device and deactivating installed software** (Otsuka: Column 1 Line 55 -- 65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Otsuka within the system Tagawa of because (a) Tagawa teaches providing a distribution system that provides a high level of convenience for the user, while protecting copyright with an security enhanced structure that contains a plurality of storage units (incl. protected area) storing usage information / rule (Tagawa: FIG. 3C & 4D / 4C, Column 2 Line 3 -- 7, Column 9 Line 42 -- 48 and Column 7 Line 42 -- 46) (b) Otsuka teaches the software protected copy right and usage rule can be one of installing software on the information-processing device and deactivating installed software (Otsuka: Figure 16 / Element F103 -- F108, Column 1 Line 51 -- 59 / Line 60 -- 65, Column 16 Line 36 -- 62 / Line 43 -- 46, Column 13 Line 1 -- 5 and Column 20 Line 1 -- 8).

Accordingly, Tagawa in view of Otsuka teaches:

the information-processing device (Otsuka: Figure 11 / Element 2) including:

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a receiving unit operable to receive the instruction from the portable recording device (Tagawa: FIG. 3C & 4D / 4C, Column 2 Line 3 – 7, Column 9 Line 42 – 48 and Column 7 Line 42 – 46: see the same rationale set forth above); and

a control unit operable to perform, in accordance with the received instruction, one of (i) receiving software from the portable recording device and installing the received software in the information-processing device, and (ii) deactivating installed software (Otsuka: Figure 11 / Element 1 & 2 and Column 9 Line 8 – 15).

As per claim 2, Tagawa as modified teaches a software-writing device (Otsuka: Figure 11 / Element 2 & 3: the integral part of a hard disk driver and associated host computer interface is considered as a software-writing device) that includes:

an information-storage unit having stored therein software that is computer data, and license information relating to a usage condition of the software (Otsuka: Figure 11 / Element 2 & 3 and Column 8 Line 58 – 67 and Column 9 Line 56 – 58);

a reading unit operable to read the software and the license information from the information-storage unit (Otsuka: Figure 11 / Element 2 & 3 and Column 8 Line 58 – 67 and Column 9 Line 56 – 58); and

an output unit operable to output the read software and license information (Otsuka: Figure 11 / Element 2 & 3 and Column 8 Line 58 – 67, Column 9 Line 56 – 58),

wherein the portable recording device further includes:

a receiving unit operable to receive the software and the license information (Tagawa: Fig 4A: SD Memory Card's user data area / protected area: must first support read function in order to receive and store the plain text data and usage data / rule); and

a writing unit operable to write the received software to the normal storage unit and the received license information to the secure storage unit (Tagawa: Fig 4A: Recording Medium of user data area / protected area: must first support write function in order to write and store the plain text data and usage data / rule onto the recording medium as shown on the right hand side).

As per claim 3 and 4, Tagawa as modified teaches the software-writing and information-processing devices are connected to each another via a network (Otsuka: Figure 11 / Element 1 / 3 / 2 and Column 19 Line 37: a recording and reproduction apparatus and a hard disk driver can be connected in a network through a host system which is also used as a server), the output unit of the software-writing device outputs the software securely via the network (Otsuka: Column 17 Line 8 – 12: the software can be securely encrypted), the information-processing device further includes: a receiving unit operable to receive the software securely via the network; and an output unit operable to output the received software to the portable recording device (Otsuka: Figure 11 / Element 3 / 2 / 1: receiving software from the host system / server over the network and output the received software to the controller, Figure 11 / Element 11, of the recording medium – where memory card is clearly / obviously equivalent to the recording medium as taught by Otsuka), and the receiving unit of the portable recording device receives the software from the information-processing device (Otsuka: Figure 11: must be provided to receive and store data).

As per claim 6, the claim limitations are met as the same reasons as that set forth above in rejecting claim 1.

As per claim 7 and 10, the claim limitations are met as the same reasons as that set forth in the paragraph above regarding to claim 5 with the exception of the feature of using a soft key for encryption / decryption (Tagawa: Figure 4A and Column 8 Line 56 – 67).

As per claim 11, Tagawa as modified teaches the secure storage unit stores a part rather than a whole of the license information (Tagawa: Fig 3C / Element 1: the system area that stores MKB), and the tamper-resistant module stores the remaining part of the license information, extracts the part of the license information stored in the secure storage unit, generates the license information from the extracted part and the stored remaining part, and performs the judgment based on the generated license information (Tagawa: Figure 3C / Element 4 – 8, Column 9 Line 26 – 48, Column 2 Line 3 – 7, and Column 7 Line 42 – 46: also see the same rationale set forth above).

As per claim 12, Tagawa as modified teaches the license information is a permitted usage count of the software, and the tamper-resistant module judges whether installation is permitted by judging whether the permitted usage count is greater than 0, judges that installation of the software is permitted when judged to be greater than 0, outputs the instruction, and writes the permitted usage count to the secure storage unit after reducing the count by 1 (Tagawa: Column 9 Line 26 – 48).

As per claim 13, Tagawa as modified teaches the license information is a permitted usage count of the software, and the tamper-resistant module outputs the instruction when judged that deactivation of the software is permitted, and writes the permitted usage count to the secure storage unit after increasing the count by 1 (Otsuka: Column 1 Line 60 – 65 and

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Column 23 Line 20 – 26: Examiner notes Otsuka teaches using two separate parameters, namely N_p and N_i , where (a) decreasing the N_i by one (i.e. decreasing the number of times that the software has been installed) (b) N_p stores the fixed total number of times the software are permitted to be installed and therefore it is considered as obviously equivalent to increasing the permitted usage count N_p by 1 after each software de-installation).

2. Claims 8, 9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. (U.S. Patent 7,096,504), in view of Otsuka et al. (U.S. Patent 6,094,723), in view of Talstra et al. (U.S. Patent 2005/0076225).

As per claim 8, 9, 16 and 17, the claim limitations are met as the same reasons as that set forth in the paragraph above regarding to claim 5 & 7 with the exception of the feature of using the signature data.

Talstra teaches including signature data relating to the software (Talstra: Para [0006] Last sentence and Figure 2: a cryptographic hash / signature over an Effective Key Block (EKB) that is related to the software is also stored in a read-only channel by using a wobble techniques in a record / playback medium).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Talstra within the system of Tagawa because (a) Tagawa teaches providing a distribution system that provides a high level of convenience for the user, while protecting copyright with an security enhanced structure that contains a plurality of storage units (incl. protected area) storing usage information / rule and the software/ data can be securely encrypted (Tagawa: FIG. 3C & 4D / 4C, Column 2 Line 3 – 7, Column 9 Line 42 – 48 and Column 7 Line 42 – 46) and (b) Talstra teaches, in a recording / playback system, the

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digital right information such as the encryption key block and the associated digital signature can be securely stored in a read-only channel on the recording medium (Talstra: Para [0037], [0006] and [0040]).

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. (U.S. Patent 7,096,504), in view of Otsuka et al. (U.S. Patent 6,094,723), in view of Jones et al. (U.S. Patent 2002/0111996).

As per claim 14, Tagawa as modified teaches the install control program references verification information as part of the license information to determine the installation or un-installation is allowed or not and the verification information is time information (Otsuka: Column 24 Line 9 – 10 and Column 23 Line 65 – Column 24 Line 7).

However, Otsuka does not disclose expressly the license information is a permitted usage period of the software.

Jones teaches the license information is a permitted usage period of the software (Jones: Para [0295]: maximum permitted period of time is included in the license information).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Jones within the system of Tagawa because (a) Tagawa teaches providing a distribution system that provides a high level of convenience for the user, while protecting copyright with a security enhanced structure that contains a plurality of storage units (incl. protected area) storing usage information / rule (Tagawa: FIG. 3C & 4D / 4C, Column 2 Line 3 – 7, Column 9 Line 42 – 48 and Column 7 Line 42 – 46) and (b) Jones teaches the license information can a permitted usage period of the software (Jones: Para [0295] and [0289]: maximum permitted period of time is included in the license information).

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Tagawa as modified teaches:

the tamper-resistant module judges whether installation is permitted by judging whether a current date-time is within the permitted usage period, judges that installation of the software is permitted when judged to be within the permitted usage period, and outputs the instruction (Tagawa: Column 2 Line 3 – 7, Column 9 Line 42 – 48 & Jones: Para [0295] and [0289]).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Longbit Chai
Examiner
Art Unit 2131


LBC


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